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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/709,720

05/25/2004

Chengshing Lai

11249-US-PA

3719

31561

7590

11/02/2006

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE

7 FLOOR-1, NO. 100

ROOSEVELT ROAD, SECTION 2

TAIPEI, 100

TAIWAN

EXAMINER

FOX, BRYAN J

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/709,720 | | LAI ET AL. | |
| | Examiner | | Art Unit | |
| | Bryan J. Fox | | 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deluca in view of Miyashita (US005574439A).

Regarding claim 1, Deluca et al disclose a system for sending a receiving graphics messages (see column 2, lines 42-67), which reads on the claimed, "method of sending a short message via a mobile communication device." A message originator can therefore press the buttons associated with the codes to provide graphics information to a selective call terminal (see column 2, lines 51-67), which reads on the claimed, "(a) acquiring a content of a short message, said content of said short message including at least a symbol," and, "(e) sending said personalized short message." When at least one predetermined code is recognized by the data communication receiver 100, a graphics message comprising one or more graphic images is presented to the user of the receiver 100 (see column 2, lines 42-67), which reads on the claimed, "(b) acquiring a definition of said symbol; (c) acquiring an inserting content...based on said definition of said symbol; (d) inserting said inserting content to replace said symbol to generate a personalized short message." Deluca et al fail to expressly disclose the inserting content consists of a text message.

In a similar field of endeavor, Miyashita discloses a system where a code is replaced with text (see column 3, lines 26-40).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Deluca et al with Miyashita to include the above replacing a code with text in order to avoid the need for a user to enter the entire message.

Regarding claim 2, the combination of Deluca et al and Miyashita disclose the graphic images available for presenting graphic messages are preferably stored by the data communication receiver 100 in, for example, a graphics database 155 (see Deluca

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et al column 3, lines 1-17), which reads on the claimed, "said mobile communication device includes a symbol database, and said step (b) further includes acquiring said definition of said symbol from said symbol database."

Regarding claim 3, the combination of Deluca et al and Miyashita disclose codes with a predetermined character, such as '#' are used to represent a graphic (see column 4, lines 33-51) or a word can be used (see Deluca et al column 6, lines 19-36), which reads on the claimed, "said symbol includes at least one of a name replacement symbol, an appellation replacement symbol, and an supplement content replacement symbol."

Regarding claim 4, the combination of Deluca et al and Miyashita disclose the graphic images available for presenting graphic messages are preferably stored by the data communication receiver 100 in, for example, a graphics database 155 (see Deluca et al column 3, lines 1-17 and figure 2), which reads on the claimed, "said mobile communication device includes an address table database, and said step (c) further includes acquiring said inserting content from said address table database."

Regarding claim 5, the combination of Deluca et al and Miyashita disclose codes with a predetermined character, such as '#' are used to represent a graphic (see column 4, lines 33-51) or a word can be used (see Deluca et al column 6, lines 19-36), which reads on the claimed, "said inserting content includes at least one of a name replacement symbol, an appellation replacement symbol, and an supplement content replacement symbol," wherein a graphic reads on at least a supplement content.

Response to Arguments

The Applicant argues Deluca teaches away from using text it uses graphic messages because text is language specific. The Examiner respectfully disagrees. The text relied upon in Miyashita is numbers and therefore would also not be language specific.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER